



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/586,639	07/19/2006	Atsushi Matsutani	292764US8PCT	5943
22850	7590	03/22/2010		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER HARVEY, DAVID E	
			ART UNIT 2621	PAPER NUMBER
			NOTIFICATION DATE 03/22/2010	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com  
oblonpat@oblon.com  
jgardner@oblon.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/586,639	<b>Applicant(s)</b> MATSUTANI, ATSUSHI	
	<b>Examiner</b> DAVID E. HARVEY	<b>Art Unit</b> 2621	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 July 2006 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/7/2008, 11/21/2007 7/19/2006</u> .                          | 6) <input type="checkbox"/> Other: _____                          |

Art Unit: 2621

**1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.**

**2. US Patent Document #2003/0093795 to Takahashi et al. has been cited because it illustrates a system in which a combined EPG is generated (note figure 16).**

**3. The following is a quotation of the second paragraph of 35 U.S.C. 112:**

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**4. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

1) In claim 1, line 10, "the broadcasting stations set" does not have clear antecedent basis and is confusing because the term "set" seems to imply "more than one" whereas the "at least a" recitation of line 4 is inclusive of only one. Clarification is required. Similar clarification is needed in claims 9 and 10. Corresponding changes are needed in the dependent claims.

**5. 35 U.S.C. 101 reads as follows:**

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**6. Claim 10 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

The preamble of claim 10 indicates that claim 10 is directed to a program per se. Programs, per se, represent non-functional descriptive material and, as such do not fall within the meaning of statutory subject matter as defined Section 101.

Art Unit: 2621

**7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:**

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**8. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by US Patent #6,404,239 to Addington et al.**

As illustrated in Figures 4 and 8, Addington et al. discloses a two-way EPG distribution system [Note lines 18-67 of column 9; column 10; and lines 1-13 of column 11]. As disclosed the system comprises:

1) A setting means (e.g., @ 212) by which a user enters setting information identifying that portion of an EPG data base which the user desires; i.e., such EPG information, by definition, identifies/sets at least one broadcast station;

2) Communication means (e.g., @ 402) for conveying a request for the desired portion of the EPG data base to at least one external serving device (@ 202, 204) and for providing in response thereto that portion of the EPG which was requested [Note: lines 45-65 of column 9; and lines 31-39 column 10];

3) Program table creation means (e.g., @ 212) for receiving the requested portion of the EPG for display/processing; i.e., the portion of the EPG, by definition, constituting a table of programs displayed by channel/time for the desired portion [Note: lines 38-47 column 8; and lines 19-25 of column 10].

**9. Claims 3-5, 9, and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent #6,404,239 to Addington et al. for the same reasons that were set forth above for claim 1.**

**10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:**

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).**

Art Unit: 2621

**11. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent #6,404,239 to Addington et al. in view of US Patent document #2006/0193559 to Thijssen.**

**A)** Addington et al describes a system as was set forth above with respect to claim 1.

**B)** Claim 2 differs from the system disclosed by Addington et al in that Addington et al does not explicitly describe using the downloaded EPG to control a recorder.

**C)** Thijssen is cited for its discussion as to the structures conventionally used to control a video recording device via timer information provided from EPG [SEE paragraph 0002]. It would have been obvious to one of ordinary skill in the art to have utilized the EPG system described by Addington et al to obtain the timer information needed to program the recorder described in Thijssen; i.e., given that obtaining such information is what EPG were designed to do.

Art Unit: 2621

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID E. HARVEY whose telephone number is (571) 272-7345. The examiner can normally be reached on M-F from 6:00AM to 3PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Marsh D. Banks-Harold, can be reached on (571) 272-7905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/DAVID E HARVEY/

Primary Examiner, Art Unit 2621

DAVID E HARVEY  
Primary Examiner  
Art Unit 2621